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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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lms

Mailed: August 22, 2006

Cancellation No. 92044693

CONCORDE APPAREL, LLC

v.

INTERNATIONAL MARK MANAGEMENT
S.A.

Before Holtzman, Rogers and Kuhlke,
Administrative Trademark Judges.

By the Board:

International Mark Management S.A. owns U.S.
Registration No. 2378903¹ for the following mark



¹ The application resulting in U.S. Reg. No. 2378903 was filed February 23, 1999 under Section 44(e), based on Benelux Registration Number 608.852 which registration date is 1997-03-13 and due to expire 2007-03-13. The U.S. registration issued on August 22, 2000, for goods identified as: "clothing for men, woman and children, namely, shirts, waste-length shirts, skirts, coats, and skirt suits, jackets, trousers, shorts, vests, cardigans, pajamas, shoes, socks; singlets, bodices, stocking-suspenders, panties and briefs, slips, slippers, footwear, hats, scarves, neckties, raincoats, overcoats, cloaks, bathing suits, anoraks, ski trousers, and belts" in Class 25.

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for various clothing items including coats, jackets, trousers and overcoats. On June 27, 2005, Concorde Apparel, LLC filed a petition to cancel the registration, claiming that it is likely to cause confusion with its registered mark:²



Respondent has denied the salient allegations of the petition to cancel.

This case now comes up on petitioner's motion for summary judgment on its claim that the mark in respondent's registration is likely to cause confusion, mistake, and/or falsely suggest to the public that there is an association between petitioner and respondent due to the substantial similarity of the parties' marks, which are used in connection with identical or closely related goods. (Brief at 1). Based on the literal portions of the marks, the

² U.S. Reg. No. 1310165 issued December 18, 1984 for "men's topcoats, raincoats, slacks, sportcoats and suits" in Class 25, claiming first use and first use in commerce of June 13, 1983, and was renewed on February 4, 2005.

respective identifications of goods³ and the priority of use as evidenced by petitioner's registration,⁴ petitioner contends that there is no genuine issue of material fact as to the likelihood of confusion.

Respondent argues that there are genuine issues of material fact with respect to several relevant *du Pont* factors,⁵ thereby arguing against summary judgment.

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence of record and any inferences which may be drawn from the underlying undisputed facts, must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether

³ In support of this statement, petitioner submitted printouts from the Office's TARR database of third-party registrations for a wide variety of clothing items that included all of the goods sold by both parties to this proceeding.

⁴ As evidence, petitioner has submitted a status and title copy of its pleaded registration.

⁵ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

such issues are present. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

In support of its opposition to the motion for summary judgment respondent argues⁶ that there are dissimilarities between the parties' marks as a whole, namely they are visually and phonetically dissimilar, they make different commercial impressions, and the "Z" element in respondent's mark is distinctive⁷; that the goods of both parties are apparel and buyers of apparel "have been previously held to be sophisticated purchasers" (brief at 8)⁸; that there is no evidence of actual confusion; and that there is no evidence showing an association or a connection between the parties or showing substantial harm to petitioner by virtue of the

⁶ No supporting evidence was submitted on behalf of respondent's position.

⁷ Respondent argues that the "Z" in its mark resembles a lightning bolt, and asks the Board to take judicial notice of the fact that the letter "Z" is used in the names of many high performance cars. The Board declines to do so. Fed. R. Evid. 201 provides that "a judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." Respondent's request does not meet either of these requirements.

⁸ In support of this statement respondent cites various Circuit Court cases the first of which is *A&H Sportswear Inc. v. Victoria's Secret Stores Inc.*, 237 F.3d 198 (3rd Cir. 2000)(affirming district court's finding that purchasers of women's apparel were sophisticated purchasers).

existence of respondent's registration. In addition, respondent argues that it owns Registration No. 2089587, that such registration contains the same mark as in the registration that is the subject of this proceeding for "Automobiles, bicycles and motorcycles" in Class 12, and "Custom design of automobiles, bicycles and motorcycles for others, engineering services" in Class 42"⁹, and that the co-existence of this mark with petitioner's mark "may be probative of a lack of confusion" between the marks¹⁰ (brief at 10). Thus, according to respondent, on the present record, a reasonable fact finder could find that no likelihood of confusion exists. (Brief at 11).

Having carefully considered the evidence and arguments submitted by the parties in connection with this motion for summary judgment, we find that respondent has failed to demonstrate that there are genuine issues of material fact

⁹ Reg. No. 2089587 issued August 19, 1997, claiming dates of first use of 1919 and first use in commerce of 1955. Respondent submitted a photocopy of this registration, with no title and status information.

¹⁰ Petitioner argues that the registration is for widely disparate goods from petitioner's clothing goods and is of no relevance. Respondent states that the existence of this registration suggests that there are genuine issues of fact regarding the fame of respondent's mark and the strength of petitioner's mark. Respondent has neither pleaded nor argued that the existence of its other registration makes out a *Morehouse* defense, see *Morehouse Manufacturing Corporation v. J. Strickland and Company*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969), and we do not consider the argument regarding its other registration as intended to establish anything other than the existence of genuine issues of fact in regard to petitioner's claim.

and that petitioner therefore is not entitled to judgment. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The Board agrees that there are no genuine issues of material fact to be determined. As stated by the Supreme Court in *Celotex*:

The plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. In such a situation, there can be "no genuine issue as to any material fact", since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial.

Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986).

In short, there is no genuine issue that the respective marks both contain the dominant literal term "ZAGATO". If the dominant portion is the same, confusion may be likely notwithstanding peripheral differences. *See, e.g., In re Chatam International Inc.*, 380 F.3d 1340, 1343, 71 USPQ2d 1944 (Fed. Cir. 2004). Additionally, there is no genuine issue that the respective identifications include some of the same goods (in particular, both cover coats, jackets, and pants) and, as there are no channels of trade specified in either registration, these identical goods are presumed to travel in the same channels of trade to the same classes

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of purchasers. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002). Finally, based on petitioner's title and status copy of its registration, we find that petitioner can rely on the filing date of the application for that registration, namely, September 19, 1983, as a presumed date of first use, which is well before respondent's filing date of the subject registration, namely, February 23, 1999, thereby establishing priority in petitioner. *See Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 n.5 (TTAB 1985).

Accordingly, petitioner's motion for summary judgment is hereby granted, the petition to cancel is granted, and Registration No. 2378903 will be cancelled in due course.

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